Docket No.: SONY 3.0-014 (PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Gregory D. Gudorf

Application No.: 09/785,094 Group Art Unit: 2457

Filed: February 16, 2001 Examiner: H. A. El-chanti

For: METHOD AND SYSTEM FOR REMOTE ACCESS OF PERSONAL MUSIC

THIRD AMENDED APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant hereby files this amended brief on Appeal to appeal from the final rejection of claims 1-15 and 17-55 in the Final Rejection mailed October 19, 2006 in response to the Notification of Non-Compliant Appeal Brief mailed October 17, 2008.

REAL PARTIES IN INTEREST

The real parties in interest in this case are the assignees of record: Sony Corporation, a Japanese corporation, having a place of business at 7-35 Kitashinagawa 6-Chome, Shinagawa-ku, Tokyo, Japan; and Sony Electronics Inc., a New Jersey corporation, having a place of business at 1 Sony Drive, Park Ridge, New Jersey 07656. The assignment of the present application to Sony Corporation and Sony Electronics Inc. was recorded in the United States Patent and Trademark Office on February 26, 2001 at Reel 011598, Frame 0764.

RELATED APPEALS AND INTERFERENCES

At present, there are no other appeals or interferences known to Appellant, Appellant's legal representative, or the assignees, which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1-15 and 17-55 are pending. Claims 1, 31, 42, 51 and 52 are independent.

(A) Written Description Rejection

Claims 52-54 stand rejected pursuant to 35 U.S.C. § 112, first paragraph. The Examiner asserts that the claims recite subject matter not described in the specification.

(B) Anticipation Rejection

Claims 1–4, 6-10, 12-15 and 17-55 stand rejected pursuant to 35 U.S.C. § 102(e) as being anticipated by Van Zoest et al. (U.S. Patent No. 6,609,105) ("*Van Zoest*").

(C) Obviousness Rejection

Claims 5 and 11 stand rejected pursuant to 35 U.S.C. § 103(a) as being obvious over *Van Zoest* in view of Official Notice.

STATUS OF AMENDMENTS

Applicant's last filed amendment dated July 24, 2006 was in response to the prior non-final Office Action and was entered by the Examiner. Applicant has not submitted an amendment in response to the Final Office Action mailed October 19, 2006 from which this appeal is being taken.

SUMMARY OF CLAIMED SUBJECT MATTER

Applicant's invention relates to a unique system for a user to upload and provide secure access to the user's own music

anywhere. For example, in claim 1, the invention describes a method of storing audio files. The method includes a) receiving at a central location electronic files representing audio signals from a first device, (See, e.g., page 2 lines 9-11; page 8 lines 6-9; FIG. 4A reference character 208.) (b) associating the audio files with authentication identification information of a user, (See, e.g., page 2 lines 11-12; page 8 lines 11-14; page 9 lines 4-7.) (c) storing said audio files at said central location on at least a portion of a storage media, said portion uniquely associated with said authentication identification information, (See, e.g., page 2 lines 12-15; page 6 line 12 to page 7 line 5; FIG. 4A reference characters 209 and 210.) (d)receiving at said central location said authentication identification information from a second device, (See, e.g., page 2 lines 15-16; page 8 lines 16-26; FIG. 4B reference characters 220 and 222) (e)transmitting said audio files to said second device upon receipt of said authentication identification information. (See, e.g., page 2 lines 16-18; page 10 lines 4-6; FIG.4B reference character 236.) Exemplary support for these features may be found in the specification at ¶7 (page 2, lines 8-18), ¶22 (page, 6, lines 3-11), ¶23 (page 6, line 12 to page 7, line 5) and ¶¶ 25-28 (page 7, line 16 to page 9, line 18); see also FIGs. 1 and 4 (reference characters 208, 209, 210, 220, 222, 224, 226, 228, 234, 236). The subject matter of independent claims 31, 42, 51 and 52 may be compared with claim 1.

For example, claim 31 relates to a system for storing and transmitting audio information. (See, e.g., page 2 lines 19-20.) The system includes a processor and a memory. (See, e.g., page 2 lines 20-22; FIG. 2 reference characters 101 and 110.) Data stored in the memory identifies a plurality of users or devices and includes a plurality of files associated with audio

information where each said file is uniquely associated with the identity of a single user or device. (See, e.g., page 2 lines 22-27; page 6 line 12 to page 7 line 5; page 11 line 16 to page 12 line 7; page 13 lines 8-10; FIG. 2 reference characters 112 and 114.) The system also includes a set of instructions executable by the processor. (See, e.g., page 2 lines 20-22; FIG. 2 reference character 104.) The instructions condition the transmission of a song from the system to a user or device based on the identity of the user or device associated with said audio information. (See, e.g., page 2 line 20 to page 3 line 2; page 8 lines 6-11; FIG. 4B reference characters 220, 222, 224, 226, 228, 234, and 236.) Exemplary support for these features may be found in the specification at ¶8 (page 2, lines 19 to page 3, line 2), ¶22 (page, 6, lines 3-11), ¶23 (page 6, line 12 to page 7, line 5) and ¶¶ 25-28 (page 7, line 16 to page 9, line 18); see also FIGs. 1 and 4(reference characters 208, 209, 210, 220, 222, 224, 226, 228, 234, 236).

Claim 42 relates to a method of storing and transmitting songs. (See, e.g., page 3 lines 3-13.) The method includes uniquely associating a portion of the storage space on a server with a user or device to store song files each having a filename. (See, e.g., page 3 lines 4-5; page 10 lines 7-11; page 11 line 16 to page 12 line 7; page 13 lines 8-10.) The method also includes associating the portion with a first user authentication identifier. (See, e.g., page 3 lines 5-6; page 10 lines 7-14; page 11 line 16 to page 11 line 7.) The method also includes receiving the first user authentication identifier. (See, e.g., page 3 lines 6-7; page 10 lines 7-24; page 11 line 16 to page 11 line 7; FIG. 4A reference characters 208 and 304.) The method also includes receiving a song file representative of a song and storing the song file with a filename in the portion of the storage space associated with the

first user authentication identifier. (See, e.g., page 3 lines 8-9; page 7 line 16 to page 8 line 14; FIG. 4B reference characters 208 and 210.) The method also includes receiving a second authentication identifier and a request for said song file and comparing the second authentication identifier with the first user authentication identifier associated with the requested song file. (See, e.g., page 3 lines 9-12; page 8 line 15 to page 10 line 3; FIG. 4B reference characters 224, 226, and 234.) The method also includes transmitting the song file in response to said request depending upon the outcome of said step of comparing. (See, e.g., page 3 lines 12-13; page 10 lines 4-6; FIG. 4B reference character 236.) Exemplary support for these features may be found in the specification at ¶¶ 9 (page 3, lines 3-13), ¶22 (page, 6, lines 3-11), ¶23 (page 6, line 12 to page 7, line 5) and ¶¶ 25-28 (page 7, line 16 to page 9, line 18); see also FIGS. 1 and 4 (reference characters 208, 209, 210, 220, 222, 224, 226, 228, 234, 236).

Claim 51 relates to a method for storing audio files for use by multiple users to prevent access to an authorized user's audio files by other authorized users. (See, e.g., page 6 lines 13-16; FIG. 3 reference characters 112 and 114.) The method includes receiving at a central system a plurality of electronic files representing audio signals for the purpose of storing the plurality of files at the central system for multiple users. (See, e.g., page 6 line 2 to page 7 line 5; page 7 lines 23-26; FIG. 3 reference characters 112 and 114; FIG. 4A reference characters 206, 208 and 210.) The method includes storing a plurality of sets of electronic files of the plurality of audio files at the central system, each set being uniquely associated with authentication identification information of a user. (See, e.g., page 6 lines 16-24; page 7 lines 23-26; FIG. 3 reference characters 112 and 114; FIG. 4A reference character 210.) The

method also includes receiving at said central location authentication identification information of a user from a device and transmitting audio files of a set of audio files to said device upon receipt of said authentication identification information of the user. (See, e.g., page 8 line 15 to page 10 line 6; FIG. 4B reference characters 222, 224, 226, 228, 234, and 236.) The method is also operated such that different stored sets of electronic files of the plurality of audio files on the central system are exclusively accessible to different authentication identification information. (See, e.g., page 6 line 13 to page 7 line 5; FIG. 3 reference characters 112 and 114.) Exemplary support for these features may be found in the specification at ¶22 (page, 6, lines 3-11), ¶23 (page 6, line 12 to page 7, line 5) and ¶¶ 25-28 (page 7, line 16 to page 9, line 18); see also FIGS. 1 and 4 (reference characters 208, 209, 210, 220, 222, 224, 226, 228, 234, 236).

Claim 52 is a method for storing audio files for use by multiple users to prevent access to an authorized user's audio files by other authorized users. (See, e.g., page 6 line 13-16; FIG. 3 reference characters 112 and 114.) The method includes (a) receiving at a central system a plurality of electronic files representing audio signals for the purpose of storing the plurality of files at the central system for multiple users, (page 6 line 13 to page 7 line 5; page 7 lines 23-26; FIG. 3 reference characters 112 and 114; FIG. 4A reference character 208.) (b) storing a plurality of sets of electronic files of the plurality of audio files at the central system, each set being uniquely associated with authentication identification information of a user, (See, e.g., page 6 line 13 to page 7 line 5; page 7 lines 23-26; FIG. 3 reference characters 112 and 114; FIG. 4A reference character 210.) (c) receiving at said central location authentication identification information of a user

from a device, (See, e.g., page 8 lines 15-26; page 11 line 16 to page 12 line 14; FIG. 4B reference characters 220 and 222.) and (d) transmitting audio files of a set of audio files to said device upon receipt of said authentication identification information of the user. (See, e.g., page 10 lines 4-5; FIG. 4B reference characters 222 and 236.) In this method, different stored sets of electronic files of the plurality of audio files on the central system are exclusively accessible to different authentication identification information. (See, e.g., page 6 line 13-16; FIG. 3 reference characters 112 and 114.) Moreover, the central location is configured to permit concurrent submission of the authentication identification information of the user and audio file identification information from the device for transmitting at least one of the audio files to the device, without first transmitting a song selection list to the device. (See, e.g., page 9 lines 3-4; FIG. 4B reference characters 222 and 236) Exemplary support for these features may be found in the specification at ¶¶ 22, 23, 25-29, 31 and 34. ¶22 (page, 6, lines 3-11), ¶23 (page 6, line 12 to page 7, line 5) and ¶¶ 25-29 (page 7, line 16 to page 10, line 3); see also FIGS. 1 and 4 (reference characters 208, 209, 210, 220, 222, 224, 226, 228, 234, 236).

An illustrative embodiment of Applicant's methods and systems is described in the specification. For example, the specification discloses that music may be stored on a server for access by an authorized user. First, the user encodes audio compact discs from red book format or an analog source into electronic digital files. The user then causes end user computer to access the content server via the Internet (such as by logging onto a web page), supplies its User ID and then uploads the files to the content server. Using the foregoing example as illustrated in Figure 2, User1 would take a compact

disc it owned, encode "SongA" as a digital file on end user computer 60 and upload the digital file to the content server via Internet. In so doing, the user identifies the song with a string, such as "File1". (See, e.g., Applicant's Specification ¶ 25 (page 7, line 16 to page 8, line 5).)

Upon receipt of the User ID and the song file, processor of server in accordance with instructions first checks the size of the file to make sure that the user has not exceeded its space limit. If the user has, then an error notification will be sent to the user explaining the problem. Otherwise, processor will store the uploaded file into the space allocated for the particular user, and associate the file with the identifying string provided by the user. (See, e.g., Applicant's Specification ¶ 26 (page 8, lines 6-14).)

An example operation of downloading the music is when the user accesses the content server (such as by logging onto a web page) via PDA. Thus, although the user uploaded the songs with one device, the user may download the songs at a different location with a different device. The user accesses the web site maintained by content server by using wireless modem in a manner well known to those of ordinary skill in the art. The user next supplies its User ID to content server by entering the information on a web page displayed on screen. Optionally, the song may be identified at the same time as well. Processor of server searches user storage area to see whether there is any user associated with that particular ID. If the user ID is not found, an error notification is sent to the user to that effect. (See, e.g., Applicant's Specification ¶ 27 (page 8, line 15 to page 9, line 8).)

If the user ID is found, the server checks whether it has already been provided with an identification of the song to be downloaded. If not, then server may, optionally, send a list of

the identifying strings to the user. (See, e.g., Applicant's Specification ¶ 28 (page 9, lines 9-18).)

The identifier for the song is checked against the list of songs associated with that user. Using the example values of Figure 2, the string "File1" would be valid identifier because there is a song file having that identifier contained in User1's space. The string "File4", on the other hand, would not be a valid identifier even though it points to a byte-for-byte identical file with the same name in User2's space. Accordingly, the identifier must identify a song contained in the respective user's space. If the song with that identifier is not contained in the space allocated to that user in user storage user, the user is notified of the error. (See, e.g., Applicant's Specification ¶ 29 (page 9, line 19 to page 10, line 3).)

If the song is validly identified, the song is then sent from the server 70 to the PDA. Once downloaded, the song may then be played by the user. (See, e.g., Applicant's Specification ¶ 30 (page 10, lines 4-6).)

Accordingly, each user is assigned a unique identification code such that the user (or the entity to whom the user gives the code) is the only entity that can upload and download music to and from the storage space allocated to the user. This identification code is sent with, or before, the steps of uploading and downloading and is used to verify that the requester is the user associated with the particular storage space. (See, e.g., Applicant's Specification ¶ 31 (page 10, lines 7-18).)

One of the advantages of the system is that there is a copy of a song for every user, rather than giving one copy of a song to multiple users. Moreover, the user is responsible for maintaining the songs stored in their space. Thus, the

invention facilitates respect for copyright owner's rights to prevent multiple unauthorized parties from downloading the same song. (See, e.g., Applicant's Specification ¶ 34 (page 11, lines 10-15.)

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

(A) Whether the Applicant's specification satisfies the written description requirement of 35 U.S.C. 112, paragraph 1 in its description of the following elements of claim 52-55:

(1) "different stored sets of electronic files of the plurality of audio files on the central system are exclusively accessible to different authentication identification information" and

(2) "the central location is configured to permit concurrent submission of the authentication identification information of the user and audio file identification information from the device for transmitting at least one of the audio files to the device, without first transmitting a song selection list to the device."

(B) Whether the Examiner's reliance on *Van Zoest* and its later filing date under 35 U.S.C. § 102(e) to reject all of the pending claims is proper in light of Applicant's substantial evidence of an earlier conception date.

(C) Whether the Examiner's anticipation rejection of claim 52-55 is proper based on the disclosure *Van Zoest* in view of *Van Zoest's* failure to teach at least the element from claim 52 of: "the central location is configured to permit concurrent submission of the authentication identification information of the user and audio file identification information from the device for transmitting at least one of the audio files to the device, without first transmitting a song selection list to the device."

ARGUMENT

A. The Specification fully satisfies the written description requirement of 35 U.S.C. § 112 with respect to the objected to subject matter of claims 52-55.

The Examiner has rejected claims 52-55 in view of two features of claim 52 under the written description requirement of 35 U.S.C. § 112, first paragraph. The Court of Appeals for the Federal Circuit has frequently addressed the "written description" requirement of §112. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991). A uniform standard for determining compliance with the "written description" requirement has been maintained as follows: "Although [the applicant] does not have to describe exactly the subject matter claimed, ... the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (citations omitted). "[T]he test for sufficiency of support in a parent application is whether the disclosure of the application relied upon 'reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.'" *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (*quoting In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)).

The two features at issue under this standard in the Examiner's § 112 rejection are as follows:

(1) wherein different stored sets of electronic files of the plurality of audio files on the central system are exclusively accessible to different authentication identification information,

(2) wherein the central location is configured to permit concurrent submission of the authentication identification

information of the user and audio file identification information from the device for transmitting at least one of the audio files to the device, without first transmitting a song selection list to the device.

Applicant respectfully submits that both features meet the written description standard as they are fully supported by the text of Applicant's specification and one skilled in the art would recognize that the specification reasonably conveys that the inventor had possession of the claimed subject matter at the time of filing.

1. Feature 1 is fully supported by the Specification

With respect to the first wherein clause of claim 52, the specification supports the feature of different stored sets of electronic files of a plurality of audio files on the central system being exclusively accessible to different authentication identification information.[1] As previously discussed, the specification expressly discloses the purpose of allowing users to access their own audio files on a portion of a server associated with authentication identification information while other authentication identification information is for accessing other files. The specification provides:

> Accordingly, each user is assigned a unique identification code such that the user (or the entity to whom the user gives the code) is the only entity that can upload and download music to and from the storage space allocated to the user. This identification code is sent with, or before, the steps of uploading and downloading and is used to verify that the requester is the user associated with the particular storage space. (See, *e.g.*, Applicant's Specification ¶ 31 (page 10, lines 7-14).)

One of the advantages of the system is that there is a copy of a song for every user, rather than giving one copy of a song

[1] Although claim 52 with feature (1) was added during prosecution in the Applicant's most recent amendment of July 18, 2006, the feature has also been pending in claim 51 since May of 2005 without invoking any written description objection.

to multiple users. Moreover, the user is responsible for maintaining the songs stored in their space. Thus, the invention facilitates respect for copyright owner's rights to prevent multiple unauthorized parties from downloading the same song. (See, *e.g.*, Applicant's Specification ¶ 34 (page 11, lines 10-15).)

A further discussion similarly provides an example as follows:

User storage area 110 is used to store the user music files 114 uploaded by the users. Preferably, each user has a predefined amount of space allocated to its sole use, and no other user is permitted unauthorized access to any information stored in its particular space. Each user has a User ID 112 which identifies the space allocated to the user. For illustration purposes, three different user spaces are schematically shown in Figure 2 for users with ID's "User1", "User2" and "User3". User1 has three music files stored in its space, including files called "File1", "File2" and "File3" corresponding with songs named "SongA", "SongB" and "SongC", respectively. User2 also has a file stored in its space designated as "File4". However, as indicated by the "SongA" label in parenthesis next to "File4", that file may be the same song as -- and byte for byte a copy of -- "SongA" contained in File1 of User1. File1 and File4 may also be quite different even if the song is the same, such as if the same song was encoded at two different frequencies. Figure 2 also shows User3 as having three music files, "File5", "File6" and "File7" corresponding with "SongD", "SongE" and "SongA" (again), respectively. (See, *e.g.*, Applicant's Specification ¶ 23. (page 6, line 12 to page 7, line 5))

An illustration is also provided in Figure 7 of the application.

For at least these reasons, Applicant submits that the Examiner's rejection of feature 1 of claim 52 is incorrect and should be reversed.

2. Feature 2 is Fully Supported by the Specification

With respect to the second wherein clause of claim 52, the specification supports the feature of the central location being configured to permit concurrent submission of the authentication identification information of the user and audio file

identification information from the device for transmitting at least one of the audio files to the device, without first transmitting a song selection list to the device.

To this end, the specification describes that the user accesses a web site maintained by content server. (Specification ¶ 27 (page 8, lines 22-24).) The user supplies its User ID to content server by entering the information on a web page displayed on screen 75 (step 222 of FIG 4B). (Specification ¶ 27 (page 8, lines 24-26).) For example, the user may identify itself as "User1." The specification further states that "the song may be identified at the same time as well." (Specification ¶ 27 (page 9, lines 3-4).)

The specification goes on to state that:

> If the user ID is found, the server 70 checks whether it has already been provided with an identification of the song to be downloaded (step 228). If not, then server 70 may, optionally, send a list of the identifying strings to the user (step 230).

(Specification ¶ 28 (page 9, lines 9-13); see also FIG 4B.)

As illustrated in Figure 4B, step 222 states "transmit user id (and optionally song ID)." Figure 4B at step 230 further illustrates the optional sending of a song list if the user did not previously send a song identification (step 228).

For at least these reasons, Applicant submits that the Examiner's rejection of feature 2 of claim 52 is incorrect and should be reversed.

B. Applicant's Documentary and Testimonial Evidence of a Prior Conception Properly disqualifies the *Van Zoest* reference.

Presently, all claims stand rejected at least in part based on the *Van Zoest* reference, which has been identified as a reference under 35 U.S.C. § 102(e). In effort to antedate the reference, the Applicant has submitted the declarations of Marc Beckwitt, Joseph S. Littenberg, Esq., inventor Greg Gudorf and

Christopher M. Tobin, Esq. The declarations demonstrate conception prior to the January 7, 2000 filing date of the *Van Zoest* reference with both documentary and oral corroborative evidence prior to the filing date of the *Van Zoest* reference. They also demonstrate inventor and attorney diligence from prior to January 7, 2000 through the filing of a provisional patent application (60/203,684, filed May 12, 2000).

Nevertheless, relying on a case from the 1800s, the Examiner has disregarded the Applicant's evidence arguing only that the declarations do not sufficiently support a prior conception because the declarations amount to only a vague and general allegation of prior conception. Office Action at 15-16 (*citing Ex Parte Saunders*, 1183 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883) The Examiner takes this position solely with respect to the features of:

(b) associating the audio files with authentication identification information,

(c) storing the audio files at the central location on at least a portion of a storage media uniquely associated with the authentication identification information and

(d) receiving at the central location the authentication identification information from a second device.

Applicant respectfully submits that the Examiner's position is incorrect. The submitted declarations fully support Applicant's prior conception with specific facts including documentary evidence and conversations occurring before the filing date of the *Van Zoest* reference that properly disqualify this reference as prior art.

It is well-established that when a party seeks to prove conception via the oral testimony of the inventor, that party must proffer evidence corroborating that testimony. See

Mahurkar v. C.R. Bard, Inc., 79 F.3d 1572, 1577 (Fed. Cir. 1996). This rule addresses the concern that a party claiming inventorship might be tempted to describe his actions in an unjustifiably self-serving manner in order to obtain a patent or to maintain an existing patent. See *Kridl v. McCormick*, 105 F.3d 1446, 1450 ("The tribunal must also bear in mind the purpose of corroboration, which is to prevent fraud, by providing independent confirmation of the inventor's testimony.") However, there is no particular formula that an inventor must follow in providing corroboration of his testimony of conception. See *Kridl*, 105 F.3d at 1450. Rather, whether an inventor's testimony has been sufficiently corroborated is determined by a "rule of reason" analysis, in which "[a]n evaluation of all pertinent evidence must be made so that a sound determination of the credibility of the inventor's story may be reached." *Price v. Symsek*, 988 F.2d 1187, 1195 (Fed.Cir. 1993). In other words, an accompanying exhibit need not support all claimed limitations, provided that any missing limitation is supported by the declaration itself. MPEP 715.07 (700-250); See also *Ex parte Ovshinsky*, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989).

Considering this rule of reason standard, the Applicant has submitted substantial factual evidence that fully demonstrates Applicant's conception of the invention prior to the January 7, 2000 filing date of *Van Zoest*. This presented evidence starts with a summary document created by inventor Greg Gudorf that bears the date of September 27, 1999. Exhibit B1, ¶ 4. Mr. Gudorf's declaration confirms the creation of the summary document (attached to his declaration) prior to the filing date of *Van Zoest*. Exhibit B1, ¶ 4. Receipt of that document prior to the filing date of *Van Zoest* was confirmed in the declaration

of Chris Tobin, in-house patent counsel for Mr. Gudorf's employer. Exhibit B3, ¶ 2.

Significantly, the summary document describes an embodiment of a similar system being prosecuted in the pending claims. The document describes Applicant's "Your Music ... Anywhere" system which was designed to permit users to upload their own music to a "secure" "Your Music Server" and "securely" deliver them to "qualified" devices anywhere. Exhibit B1, ¶ 4 (Attached Summary Document P. 5-6). The document further emphasizes the server-side's "per consumer" storage and its "secure operation." Exhibit B1, ¶ 4 (Attached Summary Document P. 8). A figure even illustrates the upload, storage and delivery of the person's music files. Exhibit B1, ¶ 4 (Attached Summary Document P. 7).

Notwithstanding the plain discussion and illustration of the invention in that summary document that demonstrates earlier conception, the Examiner argues that the document is "vague" with respect to claimed features of:

(b) associating the audio files with authentication identification information,

(c) storing the audio files at the central location on at least a portion of a storage media uniquely associated with the authentication identification information and

(d) receiving at the central location the authentication identification information from a second device.

Applicant respectfully submits that the Examiner is improperly requiring the existence of the identical claim language in the prior conception corroborative evidence rather than considering the evidence of the subject matter of the claimed invention. To this end, it is well established that a 37 CFR 1.131 affidavit is not insufficient merely because it does not show the identical subject matter in the activity

relied upon. If an affidavit contains facts showing a conception of the invention commensurate with the extent of the invention as claimed, the affidavit or declaration is sufficient, whether or not it is a showing of the identical subject matter involved in the activity. See *In re Wakefield*, 422 F.2d 897, 164 USPQ 636 (CCPA 1970). See MPEP § 715.02.

Moreover, in addition to the documentary evidence, the inventor has also submitted an additional declaration explaining what was meant by the language of the summary description that the Examiner contends only vaguely describes the invention. Thus, Mr. Gudorf has supplementally clarified that sending files to each user's particular disc space on a "Your Music Server" and providing "secure" access to those files with "qualified" net enabled devices was describing a system of access and storage based on supplying security information. Mr. Gudorf does so with an explicit discussion of the details of the claims and how it relates to the conceived "Your Music Anywhere" invention and that this occurred prior to the date of the *Van Zoest* reference. Exhibit B5, ¶¶ 5-9 (Attached Summary Document P. 8)

Furthermore, as it relates to the conception of the three elements that the Examiner has questioned, the Applicant has even submitted the further declaration of a witness Mark Beckwitt who had discussions with inventor Gudorf in the time frame of the Applicant's earlier conception. Mr. Beckwitt confirms Applicant's prior conception and design of the "Your Music Anywhere" system and its application to the features of the claims that the Examiner contends have not been established. Exhibit B4, ¶¶4-9. In short, Mr. Beckwitt's declaration fully corroborates Mr. Gudorf's testimony concerning the conception of a system consistent with the elements of the claims by his

discussions with the inventor prior to the filing date of *Van Zoest*.

For at least these reasons, Applicant respectfully submits that the Examiner's continued reliance on the *Van Zoest* as a 35 U.S.C. § 102(e) reference is improper. Applicant's date of conception prior to the filing date of *Van Zoest* properly disqualifies the reference. Thus, Applicant requests that the Board reverse the Examiner's rejection and disqualify the reference.

C. *Van Zoest* does not Disclose all Elements of Applicant's invention

The Examiner has rejected claims 52-55 as being anticipated by *Van Zoest*. Independent claim 52 defines:

> A method for storing audio files for use by multiple users to prevent access to an authorized user's audio files by other authorized users comprising:
>
> (a) receiving at a central system a plurality of electronic files representing audio signals for the purpose of storing the plurality of files at the central system for multiple users,
>
> (b) storing a plurality of sets of electronic files of the plurality of audio files at the central system, each set being uniquely associated with authentication identification information of a user,
>
> (c) receiving at said central location authentication identification information of a user from a device, and
>
> (d) transmitting audio files of a set of audio files to said device upon receipt of said authentication identification information of the user;
>
> wherein different stored sets of electronic files of the plurality of audio files on the central system are exclusively accessible to

> different authentication identification information, and
>
> wherein the central location is configured to permit concurrent submission of the authentication identification information of the user and audio file identification information from the device for transmitting at least one of the audio files to the device, without first transmitting a song selection list to the device.

This invention is not disclosed by *Van Zoest*. Notably, *Van Zoest* describes a system in which a user must separately log on to the audio file system before access to a song may be selected by a user's device. *Van Zoest*, col. 11, lines 7-31. With respect to the feature of concurrent submission of authentication information and audio files information as identified above, disregarding this col. 11 disclosure of *Van Zoest's*, the Examiner has relied on col. 18, line 55 to col. 19, line 50. It is unclear why the Examiner has cited that section as it does not discuss the feature at issue. That section describes the desire for preventing "concurrent" users from using a single user account on the *Van Zoest* system. It does not disclose or teach Applicant's invention nor even the Applicant's claimed feature of the central location being configured to permit concurrent submission of the authentication identification information of the user and audio file identification information from the device for transmitting at least one of the audio files to the device. Thus, the anticipation rejection of claim 52 is improper.

Furthermore, claims 53-55, which depend from claim 52 and incorporate the allowable subject matter of claim 52, may be compared with the subject matter of claim 52 and for at least these reasons are similarly in condition for allowance.

For at least these reasons, Applicant requests that the Board reverse the Examiner's anticipation rejection of claims 52-53. The Examiner has not established a *prima facia*

anticipation rejection since all of the elements of these claims are not disclosed in the *Van Zoest* reference.

CONCLUSION

For at least these reasons, Applicant respectfully requests that the Board reverse the Examiner's present rejections. More specifically, Applicant requests that the Board reverse the Examiner's written description rejection of claims 52-55 in view of the disclosure in the Applicant's specification that satisfies 35 U.S.C. § 112, first paragraph. Applicant further requests that the Board reverse the Examiner's improper reliance on the *Van Zoest* reference as 35 U.S.C. § 102(e) prior art in view of the Applicant's properly demonstrated conception date prior to the filing date of *Van Zoest*. Finally, Applicant requests that the Board reverse the Applicant's anticipation rejection of claims 52-55, which are not disclosed or taught in the cited portions of the *Van Zoest* reference relied upon by the Examiner.

Dated: November 10, 2008

Respectfully submitted,

By _____

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APPENDIX A - CLAIMS

1. (previously presented) A method of storing audio files comprises:

(a) receiving at a central location electronic files representing audio signals from a first device,

(b) associating the audio files with authentication identification information of a user,

(c) storing said audio files at said central location on at least a portion of a storage media, said portion uniquely associated with said authentication identification information,

(d) receiving at said central location said authentication identification information from a second device,

(e) transmitting said audio files to said second device upon receipt of said authentication identification information.

2. (original) The method of claim 1 wherein said server is a web server and said files and information are received and transmitted via the Internet.

3. (original) The method of claim 1 wherein at least one of said devices is a general purpose computer.

4. (original) The method of claim 3 wherein at least one of said devices is a personal computer.

5. (original) The method of claim 1 wherein said second device is installed in an automobile.

6. (original) The method of claim 1 wherein at least one of said devices is a personal digital assistant.

7. (original) The method of claim 6 wherein said personal digital assistant receives said audio files via wireless communication.

8. (original) The method of claim 1 further comprising encoding said electronic files from a source of audio information.

9. (original) The method of claim 8 wherein said source is a compact disk.

10. (original) The method claim 1 wherein said electronic files are compatible with the MPEG format when received at said central location.

11. (original) The method claim 1 wherein said electronic files are compatible with the ATRAC3 format when received at said central location.

12. (previously presented) The method of claim 1 further comprising receiving said authentication identification information from said first device.

13. (previously presented) The method of claim 1 wherein said step of receiving at said central location said authentication identification information comprises said second device automatically sending said authentication identification information to said central location.

14. (previously presented) The method of claim 12 or 13 wherein said authentication identification information is associated with said device.

15. (original) The method of claim 14 wherein said first device and said second device are the same device.

16. (cancelled)

17. (previously presented) The method of claim 15 wherein said step of associating said audio files with identification information comprises a user sending information which identifies the user.

18. (original) The method of claim 1 wherein said identification information is sent from said first device when said first device is connected to said central location via a network.

19. (original) The method of claim 18 wherein said network is the Internet.

20. (previously presented) The method of claim 19 wherein said authentication identification information is sent automatically by said first and second devices to said central location.

21. (original) The method of claim 1 further comprising the step of receiving at said central location a request for at least one of said files and wherein said step of transmitting comprises transmitting said at least one of said files.

22. (original) The method of claim 21 further comprising the step of comparing the identification information associated with said requested file with the identification information

received during said step of receiving said identification information from said second device, and said step of transmitting is conditional upon the results of said comparison.

23. (original) The method of claim 22 further comprising the step of transmitting to said second device a list of the files associated with the identification information received from said second device.

24. (original) The method of claim 23 further comprising comparing the size of the electronic file with the amount of said portion uniquely associated with said identification information, and wherein performance of said step of storing is conditional upon the result of such comparison.

25. (original) The method of claim 24 further comprising transmitting a notification to the user if the size of the electronic file plus the size of other files stored in said portion is greater than the amount of said portion.

26. (previously presented) The method of claim 1 wherein said second device is at a geographic location remote from said first device.

27. (original) The method of claim 1 wherein said step of transmitting comprises downloading said file.

28. (original) The method of claim 27 wherein said step of transmitting comprises streaming said file to said second device.

29. (original) The method of claim 27 wherein said step of transmitting comprises permitting said second device to permanently store said file.

30. (original) The method of claim 1 further comprising:

(a) receiving at said central location electronic files representing audio signals from a third device, said third device having different identification information,

(b) storing the audio files from said third device on a portion of said storage media that is different from the portion uniquely associated with said identification information associated with said audio files from said first device.

31. (original) A system for storing and transmitting audio information comprising:

a processor;

memory;

data stored in said memory, said data identifying a plurality of users or devices, said data further comprising a plurality of files associated with audio information, each said file being uniquely associated with the identity of a single user or device;

a set of instructions executable by said processor, said instructions conditioning the transmission of a song from the system to a user or device based on the identity of the user or device associated with said audio information.

32. (original) The system of claim 31 wherein the total size of files stored in said data for a particular user or device is limited.

33. (original) The system of claim 32 wherein a file associated with a first user is identical to a file associated with a second user and said data comprises two copies of said file.

34. (original) The system of claim 31 wherein said system comprises a server.

35. (original) The system of claim 34 further comprising an audio player connected via a network to said server, said audio player being identified by at least some of the data identifying a plurality of users or devices.

36. (original) The system of claim 35 wherein said audio player comprises memory containing information identifying said player.

37. (original) The system of claim 36 wherein said audio player further comprises a speaker and a processor for playing said file.

38. (original) The system of claim 36 wherein said audio player sends the identification information automatically to said server.

39. (original) The system of claim 36 wherein said remote device is a PDA.

40. (original) The system of claim 36 wherein the identification information comprises a GUID.

41. (original) The system of claim 31 wherein said identification information comprises a portable audio player.

42. (previously presented) A method of storing and transmitting songs comprising:

uniquely associating a portion of the storage space on a server with a user or device, the storage space to store song files each having a filename;

associating said portion with a first user authentication identifier;

receiving said first user authentication identifier;

receiving a song file representative of a song; and

storing said song file with a filename in the portion of said storage space associated with said first user authentication identifier;

receiving a second authentication identifier and a request for said song file;

comparing said second authentication identifier with the first user authentication identifier associated with said requested song file;

transmitting said song file in response to said request depending upon the outcome of said step of comparing.

43. (original) The method of claim 42 wherein if a first file is received along with a first identifier and a second file is received along with a second identifier and said first file and second file are identical copies of one another, then said first file is stored on a portion of said storage space different from the portion where said second file is stored.

44. (original) The method of claim 43 further comprising the step of tracking the number of times a song file has been transmitted.

45. (original) The method of claim 42 wherein said step of storing said song file in the portion of said storage space associated with said first identifier occurs prior to said step of associating said portion with a first identifier.

46. (original) The method of claim 42 wherein said step of receiving said song file comprises receiving said song file from said user.

47. (original) The method of claim 42 wherein said step of receiving said song file comprises receiving said song file from a bank of song files.

48. (original) The method of claim 47 further comprising the step of said song bank preventing access to said song file stored at said song bank for an amount of time.

49. (original) The method of claim 48 wherein said amount of time is determined by the number of times a user is permitted to download the song.

50. (previously presented) The method of claim 1 wherein the authentication identification information comprises a GUID.

51. (previously presented) A method for storing audio files for use by multiple users to prevent access to an authorized user's audio files by other authorized users comprising:

(a) receiving at a central system a plurality of electronic files representing audio signals for the purpose of storing the plurality of files at the central system for multiple users,

(b) storing a plurality of sets of electronic files of the plurality of audio files at the central system, each set being uniquely associated with authentication identification information of a user,

(c) receiving at said central location authentication identification information of a user from a device, and

(d) transmitting audio files of a set of audio files to said device upon receipt of said authentication identification information of the user;

wherein different stored sets of electronic files of the plurality of audio files on the central system are exclusively accessible to different authentication identification information.

52. (previously presented) A method for storing audio files for use by multiple users to prevent access to an authorized user's audio files by other authorized users comprising:

(a) receiving at a central system a plurality of electronic files representing audio signals for the purpose of storing the plurality of files at the central system for multiple users,

(b) storing a plurality of sets of electronic files of the plurality of audio files at the central system, each set being uniquely associated with authentication identification information of a user,

(c) receiving at said central location authentication identification information of a user from a device, and

(d) transmitting audio files of a set of audio files to said device upon receipt of said authentication identification information of the user;

wherein different stored sets of electronic files of the plurality of audio files on the central system are exclusively accessible to different authentication identification information,

wherein the central location is configured to permit concurrent submission of the authentication identification information of the user and audio file identification information from the device for transmitting at least one of the audio files to the device, without first transmitting a song selection list to the device.

53. (previously presented) The method of claim 1 wherein the central location is configured to permit concurrent submission of the authentication identification information of the user and audio file identification information by the second device.

54. (previously presented) The system of claim 31 wherein the set of instructions executable by said processor permit concurrent submission of the identity of the user and a song identification as a condition of the transmission of the song.

55. (previously presented) The method of claim 42 further comprising receiving concurrent information in a request, the concurrent information comprising a request for a particular song file representative of a song and said first user authentication identifier; and transmitting the song file

upon authenticating the request with the first user authentication identifier.

APPENDIX B - EVIDENCE

(1) Declaration of Greg Gudorf attached in this appendix as Exhibit B1 previously filed on October 20, 2005.

(2) Declaration of Joseph Littenberg, Esq. attached in this appendix as Exhibit B2 previously filed on October 20, 2005.

(3) Declaration of Christopher M. Tobin, Esq. attached in this appendix as Exhibit B3 previously filed on October 20, 2005.

(4) Declaration of Marc Bewitt attached in this appendix as Exhibit B4 previously filed on July 24, 2006.

(5) Supplemental Declaration of Greg Gudorf attached in this appendix as Exhibit B5 previously filed on March 15, 2006.

APPENDIX C - RELATED PROCEEDINGS

None known at this time.